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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/336,103	06/18/1999	KAREN M. DOWNS	960296.95912	7263
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26710 7590 11/19/2002

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EXAMINER

WILSON, MICHAEL C

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 11/19/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/336,103**

Applicant(s)  
**Downs et al.**

Examiner  
**Michael C. Wilson**

Art Unit  
**1632**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 20, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 16, 18, and 27-29 is/are pending in the application.
- 4a) Of the above, claim(s) 1-13, 15, 16, 18, and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1632

### **DETAILED ACTION**

The amendment filed 8-2-02, paper number 18, has been entered. Applicant's arguments therein have been fully considered but they are not persuasive.

#### ***Election/Restriction***

Claims 1-13, 15, 16, 18 and 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

Claims 27 and 28 are under consideration as they relate to a method of observing vascularization in culture. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

1. Claim 27 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 is indefinite because it is dependent upon claim 28 which does not have a "test compound." Therefore, the "test compound" in claim 27 lacks antecedent basis. Contrary to applicants statement, the amendment was not suggested by the examiner. "Nor would the limitation in claim 27 [test compound] have antecedent basis in claims 28 or 29 if dependent therefrom." Clarification is required.

Art Unit: 1632

***Claim Rejections - 35 USC § 102***

2. Claims 27 and 28 remain rejected under 35 U.S.C. 102(b) as being anticipated by Downs (Feb. 1995, Development, Vol. 121, pages 407-416) for reasons of record.

Downs taught isolating allantoic tissue, culturing the tissue *in vitro*, transplanting the allantoic tissue to an embryo and observing the allantois, specifically observing the attachment of the allantois to the chorion (pg 408, col. 2; pg 409, col. 1, para. 1; pg 411, para. bridging col. 1 and 2). Treating allantoic tissue with a compound as claimed is equivalent to contacting the allantoic tissue with an embryo as taught by Downs. In addition, Downs treated the allantoises with [<sup>3</sup>H]methyl thymidine (page 408, col. 2, para. 3) and observing the effect of [<sup>3</sup>H]methyl thymidine on growth and development (page 409, col. 1, line 14). Claim 27 is included because the dependency of the claim is unclear.

Applicants discussion of the difference between Downs and the teachings in the specification are noted. However, the claims do not differ from the teachings of Downs for reasons of record. Applicants argue Downs does not teach “observing the vascularization...” and “alteration in the vascularization of the allantoic tissue...” (pg 6 of arguments). Applicants argument is not persuasive. First, pg 5 of applicants arguments states one could conclude from Downs that while blood vessels were introduced into the allantois, their origin was unclear. Therefore, Downs taught blood vessels were present in the allantois and were observed. Second, the claims do not require vascularization or alteration of the vascularization of the allantois; the claims merely requires observing whether it does or does not occur which is taught by Downs.

Art Unit: 1632

Applicants argue Downs did not teach the allantois vascularized on its own. Applicants argument is not persuasive because the claims do not require the allantois vascularized on its own. Applicants argue Downs did not teach where the blood vessels of the allantois originated. Applicants argument is not persuasive because the claims do not require the blood vessels of the allantois have a particular origin; the claims merely require observing the vascularization of the allantois. Applicants argue Downs did not teach when allantoic vascularization begins. Applicants argument is not persuasive because the claims do not require the vascularization of the allantois begins at a certain time. Applicants argue the chorion is not required for allantoic vascularization. Applicants argument is not persuasive because the claims do not require the absence of the chorion.

***Conclusion***

No claim is allowed.

Inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-0120.

Questions of formal matters can be directed to the patent analyst, Dianiece Jacobs, who can normally be reached on Monday through Friday from 9:00 am to 5:30 pm at (703) 305-3388.

Questions of a general nature relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

If attempts to reach the examiner, patent analyst or Group receptionist are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

The official fax number for this Group is (703) 308-4242.

Michael C. Wilson



MICHAEL C. WILSON  
PATENT EXAMINER